

REMARKS

As before, claims 1-20 and 22-24 are pending in this application. Of these, claims 1, 8, 14 and 22 are independent. Claims 1-20 and 22 currently stand rejected as obvious in view of Webb (U.S. 2002/0143664) (hereinafter “Webb”). Claim 23 stands rejected as obvious in view of Webb, further in view of Robbins (U.S. 2002/0029386) (hereinafter “Robbins”). Claim 24 stands rejected as obvious in view of Webb/Robbins, further in view of Liao (US 2003/0005466) (hereinafter “Liao”). It is submitted that the rejections are improper, for reasons to be discussed below, and favorable reconsideration is requested.

As an initial matter, applicant previously noted the impropriety of similar rejections. Although the previously noted deficiencies have not been corrected, applicant’s prior comments will not be repeated here other than by their express incorporation by reference.

The claim language has been ignored

The action notes that the applicant’s amendments caused a “new ground of rejection.” However, the newly added language has been only superficially addressed in the action. To be clear, the action indeed restates the new language, but fails to identify anything in Webb that would teach what is recited in that language. Moreover, the action fails to recognize that its position on the new claim language is logically inconsistent with its position on the pre-existing claim language.

As to the first point, the action states that Webb teaches “sending a subscriber notification including an indicator of an action associated with the event … to [1] cause a notification to be conveyed to the user and to [2] additionally cause the action to be automatically executed.” However, the cited section of Webb (paras. 30-32) makes no mention of a dual purpose notification that causes user notification to occur and that also causes the action to be executed. Applicant’s review confirms that the remainder of Webb also fails to address this element.

Webb thus fails to teach at least this element for which it was cited, and the rejection cannot stand. Favorable reconsideration of claim 1 is requested. Moreover, claims 8 and 14 contain similar language for which, again, no teaching is found or cited in Webb. Thus, favorable reconsideration of claims 8 and 14 is requested as well.

The language of claim 22 similarly requires that the notification transmitted to the subscriber includes instructions to automatically perform the action. Again, there is nothing in Webb that would indicate that the notification can serve this purpose. Thus, favorable reconsideration of claim 22 is also requested.

The Office's position is illogical and is not self-consistent

To circumvent the plain claim language, the Examiner indicates that the term "action" in the claims should be understood to encompass automatically querying the Internet for gift web sites, providing the notification in question, and automatically including links to gift merchant web sites. *See* Office Action at page 3. However, not only does this take the claim language far beyond its broadest reasonable interpretation, but it is also utterly illogical and lacks internal consistency.

Recall that the claim tells us that receipt of the notification causes the "action" to be automatically executed. Does receipt of the notification cause the prior querying of web sites? Of course not, and how could it? Does receipt of the notification cause the notification to be sent? Again, of course it doesn't, and logically couldn't.¹ Finally, as noted in greater detail below, the links are part of the reminder, not some separate "action." In fact, links are not actions at all, and the providing of links, while arguably an "action," fails to match the "action" previously recited in the claim. As discussed further below, these two recitations of "action" refer to the same single action.

In other words, actions that are prior to the notification cannot have been caused by the notification. In addition, the recited action cannot be one and the same with the recited notification unless one or the other limitation is ignored. Surely the MPEP does not allow express limitations to be ignored in the quest for the broadest reasonable interpretation.

With respect to claim 22, this claim requires that the call center receive from a subscriber an indication of an event and an action associated with the event. Later, a notification, including instructions to automatically perform the action, is transmitted to the subscriber. Clearly, the action in question must be specified by the user, ruling out any of the

¹ If the Examiner means instead that the recited "notification" is a visual notification to be conveyed to the user rather than the transmitted notification, then this still leads to a lack of self-consistency. In particular, if Webb's user reminder is the recited "action," then what in Webb teaches the required notification "conveyed to the user"? (unless they're one and the same, i.e., one limitation or the other is impermissibly ignored).

occurrences alleged earlier in the action to constitute the recited “action.” However, in specifically addressing claim 22, the Office does not provide any logical alternatives to fill this hole.

The sending of the event and action are allegedly taught at paragraph 27 of Webb. See Office Action at p. 7. The cited section of Webb pertains to several things apparently supplied by the user, including names, gift ideas, and event dates. None of these appear to specify an action that is later automatically executed. Clarification is respectfully requested.

With respect to the last clause of claim 22, i.e., the later transmission of a notification back to the subscriber including instructions to automatically perform the action, the Examiner cites paragraphs 29-32 of Webb. With respect to items that may be sent to a subscriber, the cited paragraphs discuss sending (1) a reminder notification including within it a number of links, and (2) periodic updates of gift ideas and event date information. It is apparent that neither of these sets of information includes instructions to automatically perform any action, let alone one of the “actions” included in paragraph 27 of Webb (as noted above, paragraph 27 does not specify any actions to be later performed)

Summary and Conclusion

In summary, claims 1, 8, and 14 pertain to a system wherein a transmission to a subscriber causes (1) a notification to be conveyed to the user, and (2) an action to be automatically executed. Webb pertains to a system that really just provides a user notification without any automatic follow-up action. In attempting to compare the two, the Examiner runs afoul of both law and logic. The Examiner points to several things in Webb as allegedly corresponding to the recited “action” of the present claims.

However, when pointing to actions that take place with or before the sending of the notification, the Examiner violates the rule of temporal causality -- present actions can’t affect the past. And when the Office alleges that the recited action comprises all or part of the recited notification (i.e., a link, even if such is erroneously considered to be an action), the

Office ignores express claim terms under the rationale of “broadest reasonable interpretation.”²

With respect to claim 22, which requires that the user first specify an event and an action and then later receive a notification that automatically invokes the action, the Office has neglected to point to any action in Webb that is both (1) initially user-specified and (2) later automatically executed via a notification.

Accordingly, Webb does not teach the limitations for which it is cited, and does not render any pending claim unpatentable under either §102 or §103.

Applicant respectfully submits that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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² It will be appreciated that Webb's links are unquestionably part of the reminder or notification itself. *Please see* Webb at Fig. 3, stage 214 ("[T]he reminder including links to relevant gift merchant web sites.")